

## ADMINISTRATIVE PANEL DECISION

Carrefour S.A., Atacadão S.A. v. Gabriel Silva  
Case No. D2023-4424

### 1. The Parties

The Complainants are Carrefour SA, France and Atacadão S.A., Brazil represented by IP Twins, France.

The Respondent is Gabriel Silva, Brazil.

### 2. The Domain Name and Registrar

The disputed domain name <atacadaonlinesolucoes.com> is registered with Squarespace Domains LLC (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2023. On October 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 27, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 30, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 30, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 28, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on November 30, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is the French retail company Carrefour S.A. and its Brazilian subsidiary Atacadão S.A. (hereinafter jointly referred to as “the Complainant”).

Carrefour operates in more than 30 countries and pioneered the concept of hypermarket back in 1968; Atacadão is a Brazilian chain of warehouse stores established in 1960 and acquired by Carrefour in 2007.

The Complainant owns numerous trademark registrations in different regions of the world for the brand ATACADÃO and ATACADAO, such as European Union Trade Mark No. 012020194, registered on May 24, 2015, and the Brazilian trademarks nos. 006785344, registered on October 10, 1978, and 006937497, registered on May 25, 1979.

The disputed domain name was registered on October 11, 2023.

From the evidence provided by the Complainant, the disputed domain name was used to host a website reproducing the Complainant’s logo and trademark ATACADÃO, and aiming to collect Internet user’s personal data and credit card numbers, on the promise of granting a monetary gift.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant makes the following contentions:

- The disputed domain name is confusingly similar to the Complainant’s trademark ATACADÃO.

The Complainant has demonstrated rights on the terms ATACADAO and ATACADÃO. The disputed domain name is highly similar to the earlier well-known trademarks ATACADÃO. Indeed, the disputed domain name includes the trademarks ATACADÃO in their entirety. The second part of the disputed domain name is the term “nlinesolucoes”. Actually, users are led to read and understand the disputed domain name as “atacaao online soluções” in Portuguese language, which can be translated as “atacaao online solutions” in English. The merger of the final letter “o” of “atacaao” with the first letter of “online” is hardly noticeable and the Complainant’s earlier trademarks are immediately recognizable at the beginning of the disputed domain name as the only distinctive element. The use of lower-case letter format on the one hand and the addition of the Top-Level Domain (“TLD”) on the other hand, are not significant in determining whether the disputed domain name is identical or confusingly similar to the trademarks of the Complainant. In many previous decisions, panels considered that the incorporation of a well-known trademark in its entirety may be sufficient to establish that the domain name is identical or confusingly similar to the Complainant’s trademark.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant performed searches and found no ATACADÃO trademark owned by the Respondent and there is no evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization. Secondly, the Respondent reproduces the Complainant’s earlier registered trademarks ATACADÃO in the disputed domain name without any license or authorization from the Complainant, which is strong evidence of the lack of legitimate interests. Thirdly, the Respondent has

not, before the original filing of the Complaint, used or prepared to use the disputed domain name in relation to a *bona fide* offering of goods or services. In fact, users accessing the disputed domain name are welcomed by a page where the Complainant's ATACADÃO trademark is prominently placed (together with the term "cartao", therefore referring to the Complainant's credit card service) as if the disputed domain name and the corresponding website were managed by, affiliated with or authorized by, the Complainant. Users accessing this domain name via mobile devices are then redirected to a page where personal data is requested (sensible data as their credit card information and their Brazilian individual taxpayer identification number) in order to release an alleged USD 500,00 gift. Other users instead access a white page. Therefore, it is clear from the evidence available that the Respondent is actively trying to carry out fraudulent activities through the disputed domain name, misleading Internet users, trying to collect users' personal data and illicitly using the Complainant's trademarks. Fourthly, since the adoption and extensive use by the Complainant of the trademarks ATACADÃO predate the registration of the disputed domain name, the burden is on the Respondent to establish the Respondent's rights or legitimate interests the Respondent may have or have had in the disputed domain name. None of the circumstances which set out how a respondent can prove rights or legitimate interests in the disputed domain name, are present in this case.

- The disputed domain name was registered and is being used in bad faith.

Firstly, it is inconceivable that the Respondent ignored the Complainant or its earlier rights on ATACADÃO. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a trademark by an unaffiliated entity can by itself create a presumption of bad faith. Secondly, it is highly likely that the Respondent chose the disputed domain name because of its identity with or similarity to a trademark in which the Complainant has rights and legitimate interest. This was most likely done in the hope and expectation that Internet users searching for the Complainant's services and products would instead come across the Respondent's website, and to carry out a fraudulent phishing scheme passing off as the Complainant's website. Such use cannot be considered a good faith use. Thirdly, the Complainant's ATACADÃO trademark registrations significantly predate the registration date of the disputed domain name. In this regard, previous panels have established that knowledge of the Complainant's intellectual property rights, including trademarks, at the time of registration of the disputed domain name, proves bad faith registration. Furthermore, a simple search on an online search engine shows results only related to the Complainant. Fourthly, the current use of the disputed domain name may not be considered a good faith use. In addition, the disputed domain name is used to host a website seeking to collect sensitive personal and financial information from unsuspecting Internet users which are customers of the Complainant. The Respondent's phishing activity evidences a clear intent to mislead individuals and to create an unauthorized association between the Respondent and the Complainant's well-known trademarks. Lastly, the Respondent has already been involved in other UDRP cases, carrying out similar phishing schemes and also seeking to acquire personal or account information from customers of the Complainant, where the panel concluded that the respective domain names were registered and were being used in bad faith, ordering the transfer of the domain names to the complainant.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name; and

- (iii) The disputed domain name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Panel has no doubt that “atacadao” is a term directly connected with the Complainant’s trademark. Annexes 4, 5 and 6 to the Complaint show numerous trademark registrations for ATACADÃO, as early as in 1978.

The disputed domain name incorporates the Complainant’s trademark ATACADÃO, with the addition of the term “nlinesolucoes” (which, despite the absence of the initial letter “o”, it is the Portuguese version of “online solutions”). The disputed domain name also presents the TLD “.com”.

Previous UDRP decisions have found that the mere addition of terms (such “nlinesolucoes”, in this case<sup>1</sup>) to a trademark in a domain name does not prevent a finding of confusing similarity. This has been held in many UDRP cases (see, e.g., *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#); *AltaVista Company v. S.M.A., Inc.*, WIPO Case No. [D2000-0927](#)).

It is also already well established that the addition of a TLD such as “.com” is typically irrelevant when determining whether a domain name is confusingly similar to a complainant’s trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark, and that the Complainant has satisfied the first element of the Policy.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

Based on the Respondent’s default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel notes that the present record provides no evidence to demonstrate the Respondent’s intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the Respondent has not indicated any reason to justify why it has chosen the specific term “atacadaonlinesolucoes” to compose the disputed domain name. Also, the Complainant brought evidence that suggests that the disputed domain name was recently used to collect Internet users’ personal data and credit card information, suggesting it was related to the Complainant “credit card solutions”.

Given the Complainant’s primary operations in Brazil under the brand ATACADÃO, the same country of residence of the Respondent, the composition of the disputed domain name naturally implies affiliation with the Complainant. However, the Complainant has not licensed or authorized the use of its trademark to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the

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<sup>1</sup> The absence of the letter “o” is hardly noticeable, as the final letter of the previous word (the Complainant’s trademarks ATACADAO and ATACADÃO) is also an “o”.

disputed domain name.

Furthermore, panels have held that the use of a domain name for illegal activity (e.g., impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.13.1. Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

### **C. Registered or Used in Bad Faith**

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

When the disputed domain name was registered in 2023, the trademark ATACADÃO was already famous in Brazil and directly connected to the Complainant's retail services.

Therefore, the Panel concludes that it would not be feasible to consider that the Respondent – reportedly a resident of Brazil – could not have been aware of the Complainant's trademark at the time of the registration of the disputed domain name, as well as that the adoption of the expression "atacadaonlinesolucoes" could be a mere coincidence.

According to the [WIPO Overview 3.0](#), section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

Actually, the Panel considers that in the present case the addition to the Complainant's trademark of the term "nlinesolucoes" may even enhance the risk of confusion, suggesting that the disputed domain name refers to the ATACADÃO official Internet website and credit card services.

The Panel finds that the Respondent's use to host a website reproducing the Complainant's logo and trademark ATACADÃO, and directing Internet users to a log-in page likely aiming to collect Internet user's personal data and credit card numbers constitutes bad faith use.

The Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location. [WIPO Overview 3.0](#), section 3.1.4.

Therefore, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied the third element of the Policy.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <atacadaonlinesolucoes.com> be transferred to the Complainant.

*/Rodrigo Azevedo/*

**Rodrigo Azevedo**

Sole Panelist

Date: December 18, 2023